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IN THE  
**Supreme Court of the United States**

October Term, 1970

No. 70-314

**BRUNETTE MACHINE WORKS LTD.,**  
*Petitioner,*

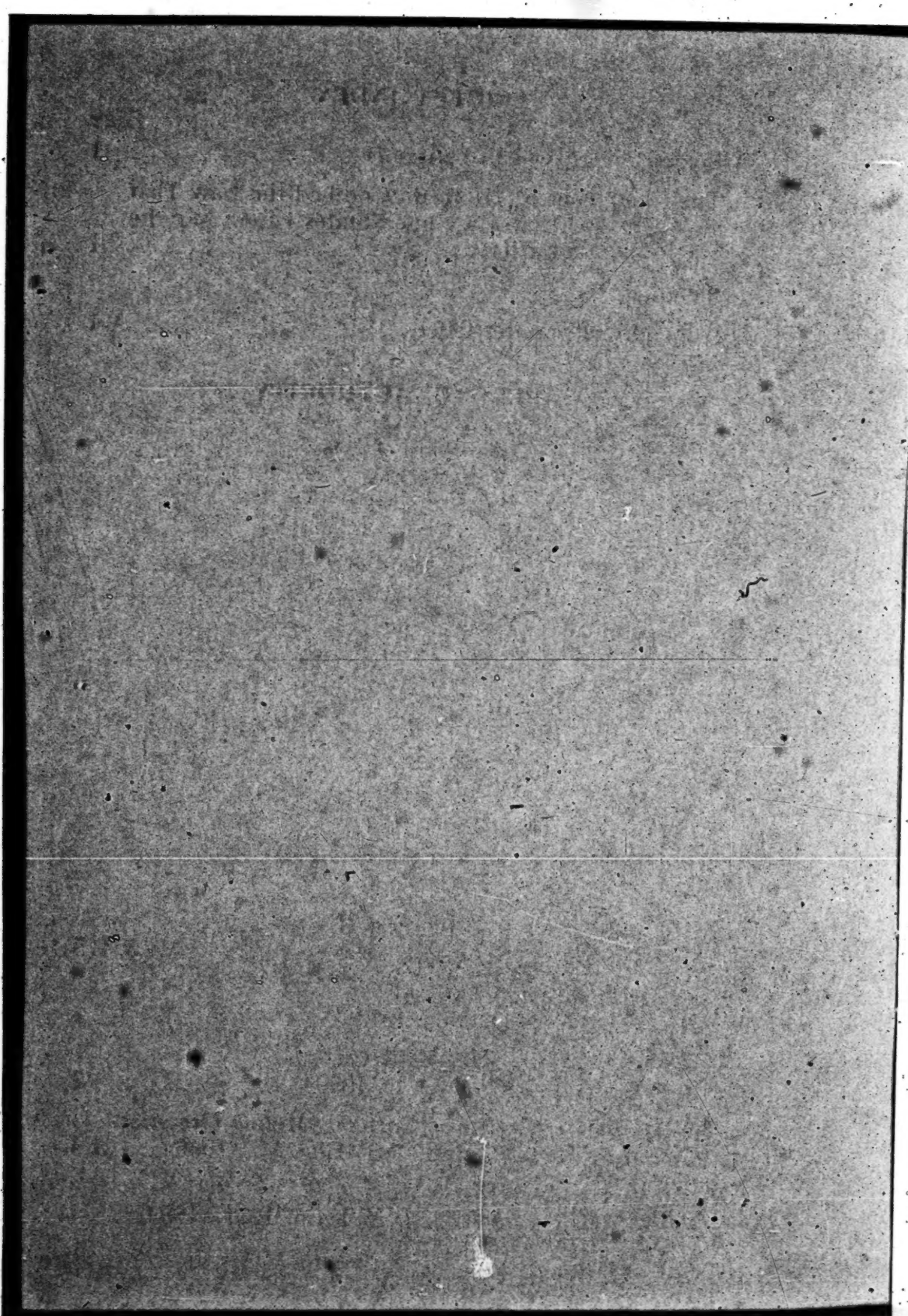
v.

**KOCKUM INDUSTRIES, INC.**  
*Respondent.*

**BRIEF IN ANSWER TO PETITION FOR A WRIT OF  
CERTIORARI TO THE UNITED STATES COURT OF  
APPEALS FOR THE NINTH CIRCUIT**

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ARGUMENT IN ANSWER TO PETITIONER

The Enactment of § 1391(d) Codified the Law That  
an Alien Infringer of a United States Patent May  
Be Sued in Any District

The cases prior to 1948 under the Act of March 3, 1897, c.395, 29 Stat. 695, and the 1911 Judicial Code derived therefrom, established that Section 48 of the 1911 Judicial Code [28 U.S.C.A. § 109 (1940 ed.)], limiting venue over patent infringers, did not apply to alien defendants. *Re Hohorst*, 1893, 150 U.S. 653, 14 S. Ct. 221, 37 L.Ed. 1211; *Barrow Steamship Co. v. Kane*, 1898, 170 U.S. 100, 18 S.Ct. 526, 42 L.Ed. 964; *United Shoe Machinery Co. v. Duplessis Independent Shoe Machinery Co., Ltd.*, C.C. Mass., 1904, 153 Fed. 930; *Sandusky Foundry & Machine*

*Co. v. De Lavaud*, N.D. Ohio, 1918, 251 Fed. 631; *Keating v. Pennsylvania Co.*, N.D. Ohio, 1917, 245 Fed. 155; and *Keller v. American Sales Book Co.*, W.D. N.Y., 1936, 16 F.Supp. 189. As stated in *Keller v. American Sales Book Co.*, *supra*, at 190, in reference to Section 48 of the 1911 Judicial Code:

"It is clear from the language of the section and from numerous authorities that section 48, *supra*, has no application to a foreign (alien) corporation which has no place of business within the District."

The 1948 Judicial Code codified the prior law and § 1391(d), 28 U.S.C.A., thereof, specifically codified the prior case law that aliens, including alien infringers of a United States patent, may be sued in any district. The Reviser's Note to § 1391(d), 28 U.S.C.A., p. 62, states:

"Subsection (d) of this section is added to give statutory recognition to the weight of authority concerning a rule of venue as to which there has been a sharp conflict of decision. See (*Sandusky Foundry and Machine Co. v. De Lavaud*, 1918, D.C. Ohio, 251 F. 631, 632, and cases cited. See also *Keating v. Pennsylvania Co.*, 1917, D.C. Ohio, 245 F. 155 and cases cited)."

In *Sandusky Foundry and Machine Co. v. De Lavaud*, *supra*, the court held that venue in a patent infringement suit against a defendant alien attached against the alien in any district in which process could be served upon the alien, notwithstanding the special patent venue statute (Section 48 of the 1911 Judicial Code) limiting venue in patent infringement cases to the district wherein the defendant is an inhabitant or has committed acts of infringement and has a regular and established place of business. The Court in *Sandusky* at p. 632-633, stated:

"The defendants who have appeared are aliens. It seems to be settled law that they are not inhabitants of

any district, and may be sued in any district within which process can be served on them. It was so held under what is now Section 48 of the Judicial Code (Act, March 3, 1911, c.231, 36 Stat. 1100 [Comp. St. 1916 §§ 1024, 1030]) in *United [Shoe Machinery] Company v. Duplessis Company* (C.C.) 133 F. 930. Such is said to be the law in *Walker on Patents* (5th Ed.) § 389. The same holding has been repeatedly made under section 51 of the Judicial Code (Comp. St. 1916, § 1033) as applied to causes of action other than suits arising under the patent laws. In *re Hohorst*, 150 U.S. 653, 14 S.Ct. 221, 37 L.Ed. 1211; *Barrow Steamship Co. v. Kane*, 170, U.S. 100, 18 S.Ct. 526, 42 L.Ed. 964; *Wind River Lumber Co. v. Frankfort Marine Ins. Co.*, 196 F. 340, 116 C.C.A. 160; *Keating v. Pennsylvania Co.* (D.C.) 245 F. 155. The reasoning applied equally to both classes of cases against alien defendants."

From the Reviser's Note it is clear that the law has been, and under § 1391(d) continues to be, that special patent venue statutes are not applicable to alien patent infringers and that venue is proper over alien patent infringers in any district wherein the alien is amenable to service of process.

The better-reasoned cases since enactment of the 1948 Judicial Code have uniformly held that § 1391(d) is applicable to alien infringers of a United States patent. *Chas. Pfizer & Co. v. Laboratori Pro-Ter Prodotti Therapeutici*, S.D. N.Y., 1967, 278 F.Supp. 148; *Olin Mathieson Chemical Corp v. Molins Organizations, Ltd.*, E. D. Va., 1966, 261 F. Supp. 436; *Japan Gas Lighter Association v. Ronson Corp.*, D.N.J., 1966, 257 F.Supp. 219; *SCM Corp. v. Brother International Corp.*, S.D. N.Y., 1970, 316 F.Supp. 1328; *Deering Milliken Research Corp. v. Stahlecker*, D.S.C. 1969, 166 U.S. P.Q. 321; and *Deering Milliken Research Corp. v. Vecchioni*, E.D. Va. 1970, 168-U.S.P.Q. 59. In contrast to the holdings of these cases, the Seventh Circuit in

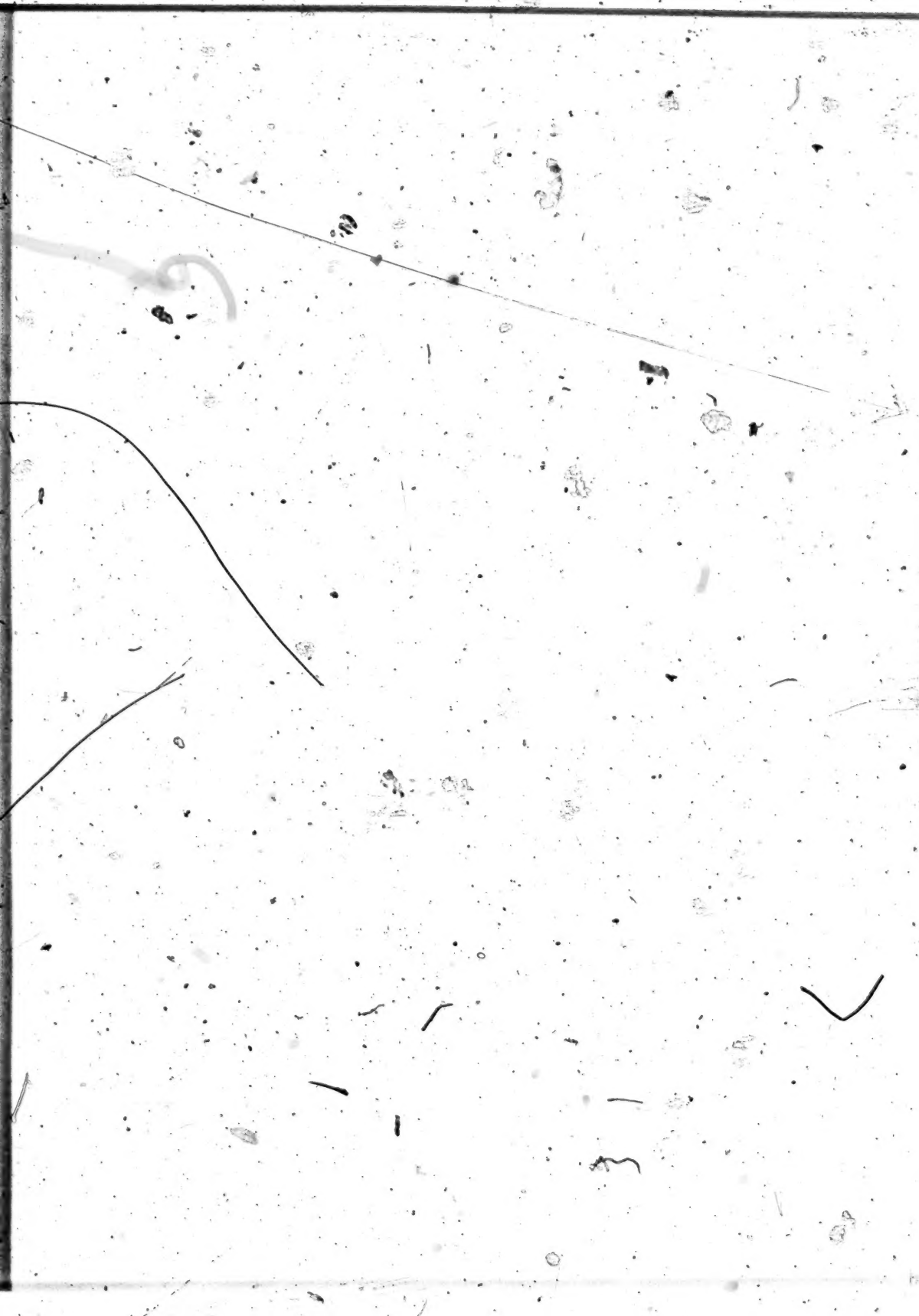
*Coulter Electronics, Inc. v. A. B. Lars Ljunberg & Co.*, 1967, 376 F.2d 743, cert. den. 389 U.S. 859, 99 S.Ct. 103, 198 L.Ed.2d 124, held that § 1400(b), 28 U.S.C.A., is the sole and exclusive provision controlling venue in patent infringement actions and is not to be supplemented by § 1391(d), citing *Fourco Glass Co. v. Transmirra Products Corp.*, 1957, 353 U.S. 222, 77 S.Ct. 787, 1 L.Ed.2d 786, for its holding that § 1400(b) is not supplemented by § 1391(c).

The emphasis placed by the Supreme Court in *Fourco* on the Reviser's Notes and the preceding judicial holdings, however, supports the conclusion that the provisions of § 1400(b) were not intended to be exclusive in suit against aliens but were to be supplemented by § 1391(d). *Chas. Pfizer & Co. v. Laboratori Pro-Ter Prodotti Terapeutici*, *supra*; *Olin Mathieson Chemical Corp. v. Molins Organizations, Ltd.*, *supra*, and *Japan Gas Lighter Association v. Ronson Corp.*, *supra*. The Supreme Court in holding that § 1400(b)'s requirements were exclusive in a suit against a domestic corporation, based its decision on the fact that Congress re-enacted the subject matter of § 1400(b) in 1948 with no expression of intent (either in the Reviser's Notes or the text) that § 1400(b) should be supplemented by § 1391(c). The prior Supreme Court decision of *Stonite Prods. Co. v. Melvin Lloyd Co.*, 1942, 315 U.S. 561, 62 S.Ct. 780, 86 L.Ed. 1026, clearly held that § 1400(b)'s predecessor [Section 48 of the 1911 Judicial Code] was the sole provision governing venue in a suit against a domestic corporation and was exclusive with respect to § 1392(a)'s predecessor [Section 52 of the 1911 Judicial Code, 28 U.S.C. (1940 ed.) § 113]. The *Fourco* decision was expressly based on the Court's conclusion that § 1400(b) enacted its predecessor provision [Section 48 of

the 1911 Judicial Code] without substantive change, 353 U.S. at 227, 77 S.Ct. at 787, and that venue practice under Section 48 was clearly narrower with regard to corporate residence than that permissible under §1391(c). *Japan Gas Lighter Association v. Ronson Corp.*, *supra*; and *Pfizer & Co. v. Laboratori Pro-Ter Therapeutici*, *supra*.

The prevailing venue practice under Section 48 of the 1911 Judicial Code was equally clear that alien corporations could be sued in any district in patent infringement actions and that Section 48 was not applicable to alien infringers. Furthermore, Congressional intent to give statutory recognition to established alien venue practice in patent infringement actions is clearly expressed by the Reviser's Note citation to the *Sandusky* case relative to §1391(d). As noted by the Court in the *Pfizer* case on motion to reconsider its decision holding that venue was proper over the alien defendant before that court:

"On the same day that this Court's decision was handed down, the Supreme Court denied certiorari in *Coulter Elec. Inc. v. A. B. Lars Ljungberg & Co.*, 389 U.S. 859, 99 S.Ct. 103, 19 L.Ed.2d 124 (1967). In *Coulter*, the Seventh Circuit relying principally on the Supreme Court's decision in *Fourco Glass v. Transmirra Prods. Corp.*, 353 U.S. 333, 77 S.Ct. 787, 1 L.Ed. 2d 786 (1957) and *Stonite Prods. Co. v. Melvin Lloyd Co.* 315 U.S. 561, 62 S.Ct. 780, 86 L.Ed. 1026 (1942), held that a suit against an alien infringer will not permit an exception to the exclusivity of the patent venue statute, and that in such a suit §1391(d) has no applicability. 376 F.2d 743 (7th Cir., 1967). *It does not appear, however, that either the Seventh Circuit or the Supreme Court had directed to their attention, or considered, the legislative history of §1391(d), as reflected in the Reviser's Note, which distinguishes it from §1391(c) and shows that §1391(d), unlike §1391(c), was intended to supplement §1400(b).*" (Emphasis added) p. 154.



## APPENDIX OF STATUTES CITED

## I.

28 U.S.C.A. (1948 ed.)

## §1391(a)

A civil action wherein jurisdiction is founded only on diversity of citizenship may, except as otherwise provided by law, be brought only in the judicial district where all plaintiffs or all defendants reside, or in which the claim arose.

## §1391(c)

A corporation may be sued in any judicial district in which it is incorporated or licensed to do business or is doing business, and such judicial district shall be regarded as the residence of such corporation for venue purposes.

## §1391(d)

An alien may be sued in any district.

## §1400(b)

Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

## II.

Judicial Code of 1911

[28 U.S.C.A. (1940 ed.)]

## Section 48 [28 U.S.C.A. §109]

In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established

place of business. If such suit is brought in a district of which the defendant is not an inhabitant, but in which such defendant has a regular and established place of business, service of process, summons, or subpoena upon the defendant may be made by service upon the agent or agents engaged in conducting such business in the district in which suit is brought.

*Section 51 [28 U.S.C.A. §112]*

• • • except as provided in sections 113-118 of this title, no civil suit shall be brought in any district court against any person by any original process or proceeding in any other district than that whereof he is an inhabitant; but where the jurisdiction is founded only on the fact that the action is between citizens of the different states, suit shall be brought only in the district of the residence of either the plaintiff or the defendant; • • •

*Section 52 [28 U.S.C.A. §113]*

• When a State contains more than one district, every suit not of a local nature, in the district court thereof, against a single defendant, inhabitant of such State, must be brought in the district where he resides; but if there are two or more defendants, residing in different districts of the State, it may be brought in either district, and a duplicate writ may be issued against the defendants, directed to the marshal of any other district in which any defendant resides. The clerk issuing the duplicate writ shall indorse thereon that it is a true copy of a writ sued out of the court of the proper district; and such original and duplicate writs, when executed and returned into the office from which they issue, shall constitute and be proceeded on as one suit; and upon any judgment or decree rendered therein, execution may be issued, directed to the marshal of any district in the same State.

